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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,814	12/06/2000	Donald Kyle	332.1114	9564

7590 08/09/2004
Davidson Davidson & Kappel LLC
485 Seventh Avenue 14th Floor
New York, NY 10018

EXAMINER

BARTS, SAMUEL A

ART UNIT PAPER NUMBER

1621

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/730,814

Applicant(s)

KYLE ET AL.

Examiner

Samuel A Barts

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,11,12,14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,11,12,14 and 16 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 6 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Applicants' amendment to claim 1 removes the claimed compound "*1-benzylamino-3-dibutylamino-propyl*" from being embraced by the genus. Note that R₅ is no longer hydrogen.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

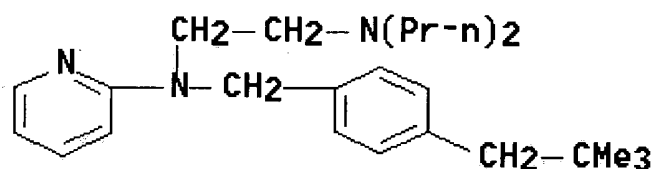
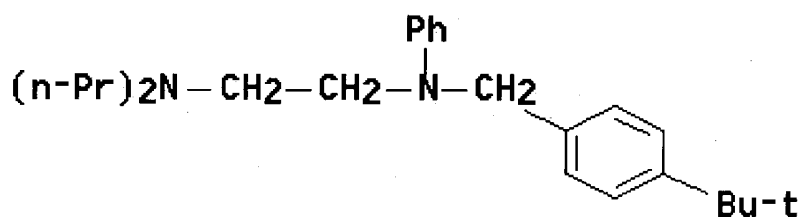
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 11, 14 and 16 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cross et al (GB 1306450).

Cross et al disclose the following compounds that are fully embraced by the claimed genus.

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Note the claimed genus is anticipated when R_1 is C_{1-10} alkyl, R_2 is C_{1-10} alkyl, R_3 is C_{1-10} alkyl, R_4 is a bond, R_5 is a 6membered aromatic or heteroaromatic ring and R_6 is C_{1-10} alkyl

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-5, 7, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross et al (GB 1306450).

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Cross et al generically disclose the claimed invention. See the genus on page 1 and the definition of R, R¹ and Y in columns 1-2 on page one. Exemplified close structural compounds are given in the 102 rejection above. The variable Y in Cross et al is an aminoalkyl defined by the formula $\text{--Alk--NR}^2\text{R}^3$ where Alkyl can be 2-4 carbons and R² and R³ can be an alkyl group containing 1-4 carbons. The aforementioned exemplified species have R² and R³ as propyl and Alkyl as ethyl.

The instant claims are substantially similar. Instant claim 12 requires that R¹ be propyl. R¹ is equivalent to the variable --Alkyl in the prior art reference. Therefore, the instant claims differ from the prior art as being directed to a subgenus. However, the instant claimed subgenus would have been obvious to one having ordinary skill in the art at the time that applicants' invention was made. One skilled in the art would have been motivated to make other compounds which fall within the genus taught by Cross et al with reasonable expectation the compounds would be useful as anti-histamines.


Instant claims 1, 3, 5, and 7 differ from the prior art reference as being directed to a subgenus. Claims 1, 3, 5, and 7 require that R¹ be propyl and that R² and R³ be at least C₄ alkyl. Both limitations fall within the genus taught by Cross et al. Also, both limitations are not far removed from the exemplified species cited in the 102 rejection. Therefore, the instant claimed subgenus would have been obvious to one having ordinary skill in the art at the time that applicants' invention was made. One skilled in the art would have been motivated to make

other compounds which fall within the genus taught by Cross et al with reasonable expectation the compounds would be useful as anti-histamines.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 571-272-2870. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Samuel A Barts
Primary Examiner
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